



15W AF \$

PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Weiner

Examiner: S. Staicovici

Serial No.: 10/606,074

Group Art Unit: 1732

Filed June 25, 2003

For: Imbedded Vinyl Products and Method of Producing Same

**APPEAL BRIEF**

Commissioner of Patents and Trademarks

P. O. Box 1450

Alexandria, Virginia 22313-1450

Sir:

Further to the Notice of Appeal filed March 26, 2007, which was accompanied with the statutory fee of \$250. The \$250 fee for the submission of an appeal brief is enclosed herewith. Please charge any additional fee or credit any overpayment to Deposit Account No. 13-3403. Three copies of this page are attached for this purpose.

**I. PRESENTATION OF THE APPEAL**

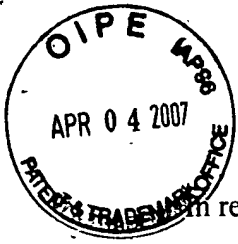
**A. Real Party in Interest**

The real party in interest is Appellants' assignee, Product Concepts Residential, LLC, a Georgia limited liability company with its principal place of business at 525-B Calahan Road, Dalton, GA 30722.

**B. Related Appeals and Interferences**

There are no related appeals and interferences.

04/09/2007 SSANDARA 00000007 133403 10606074  
01 FC:2402 250.00 DA



PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Weiner

Examiner: S. Staicovici

Serial No.: 10/606,074

Group Art Unit: 1732

Filed June 25, 2003

For: Imbedded Vinyl Products and Method of Producing Same

**APPEAL BRIEF**

Commissioner of Patents and Trademarks  
P. O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

Further to the Notice of Appeal filed March 26, 2007, which was accompanied with the statutory fee of \$250. The \$250 fee for the submission of an appeal brief is enclosed herewith. Please charge any additional fee or credit any overpayment to Deposit Account No. 13-3403. Three copies of this page are attached for this purpose.

**I. PRESENTATION OF THE APPEAL**

**A. Real Party in Interest**

The real party in interest is Appellants' assignee, Product Concepts Residential, LLC, a Georgia limited liability company with its principal place of business at 525-B Calahan Road, Dalton, GA 30722.

**B. Related Appeals and Interferences**

There are no related appeals and interferences.

### **C. Status of Claims**

At the time of the final Office Action, claims 1-20 were pending in the application. The application was initially filed with 20 claims. Claims 1, 15 and 20 were amended with an Amendment and Response filed May 18, 2006.

A copy of the claims subject to this appeal appears in Appendix A.

### **D. Status of Amendments**

No proposed amendments have been proposed or entered after final.

### **E. Summary of Invention reflecting at least the Independent Claims**

Most generally, the present invention relates to a vinyl product having embedded design material therein. (Page 1, lines 4-5). The embedded design material is selected from the group of chips and pellets (Page 5, line 12) as well as drips and streams (Page 7, line 7).

For claim 1, a conveyor belt **18** has at least a first design material **36** applied thereto by deposition (Page 4, lines 14-15). The deposited material **36** is applied without completely covering the belt **18** (Page 2, lines 19-20 and Claim 1 as originally filed). Next a first substrate layer **42** is applied over the first or second deposited materials **36,38** (Page 5, lines 6-7) with at least a portion of the design material **36** remaining in contact with the conveyor belt **18** (Page 7, lines 19-20 and Claim 1 as originally filed). The vinyl sheet product is then cured and then directed on for further processing (Page 5, lines 20-22, Claim 1 as originally filed and Fig. 1). A scrim **50** may also be applied to the first substrate layer **42** and/or a second vinyl substrate layer **54** is applied over the scrim **50** in one embodiment prior to the curing step (Page 5, lines 15-17).

For claim 15, a substrate layer having an upper surface 14 is applied on a conveyor belt 18 (Page 6, lines 2-3 and Claim 15 as originally filed). The design material 36 is then applied to the upper surface 14 so that it remains level with the top surface, if not extending a distance above the upper level 14 as shown in Figure 4 (Page 6, lines 3-10). The deposited material 36 is applied without complete covering the substrate or being completely encapsulated within the substrate (Page 2, lines 19-20, Page 6, lines 14-19, and Claim 1 as originally filed). This embodiment is also then cured (Page 5, lines 20-22, Claim 15 as originally filed and Fig. 1)

#### **F. Grounds of Rejection to be Reviewed on Appeal**

1. Whether the Examiner properly rejected claims 1-2, 11-13, 15-17 and 19 as being obvious over Weiner et al., U.S. Patent No. 6,696,004 (hereinafter "Weiner '004") in view of Lussi et al, U.S. Patent No. 5,015,516 (hereinafter "Lussi") in the Final Office Action.

2. Whether the Examiner properly rejected claims 3 and 18 as being obvious over Weiner '004, in view of Lussi in further view of Weiner et al., U.S. Patent No. 6,903,033 (hereinafter "Weiner '033") in the Final Office Action.

3. Whether the Examiner properly rejected claims 4-5 and 20 as being obvious over Weiner '004, in view of Lussi in further view of Erb, U.S. Patent No. 3,350,483 (hereinafter "Erb") in the Final Office Action.

4. Whether the Examiner properly rejected claims 6-10 as being obvious over Weiner '004, in view of Lussi in further view of Erb and Henlser, U.S. Patent No. 5,695,696 (hereinafter "Hensler") in the Final Office Action.

5. Whether the Examiner properly rejected claim 14 as being obvious over Weiner '004, in view of Lussi in further view of Suzuki et al., U.S. Patent No. 6,589,631 (hereinafter "Suzuki") in the Final Office Action.

## **II. ARGUMENT**

### **A. Obviousness Rejection of Claims 1-2, 11-13, 15-17 and 19**

#### **1. Rejection of Claims 1-2 and 13**

Weiner '004 shows the making of a vinyl sheet product with a decorative mesh embedded into the vinyl. The mesh is embedded into a top surface of a vinyl (Col. 2, lines 15-19). Nowhere in this reference is an embodiment disclosed for placing mesh on a conveyor and then a substrate applied thereto. By embedding the mesh from the top, at least two elevations of substrate result from (1) wicking up toward a top of the mesh or (2) by forming bubbles above the mesh as reflected by the claims and specification of that patent.

The Examiner correctly observes in the Final Office Action that Weiner '004 does not teach using a decorative material in the form of drips, streams chips or pellets. The Office Action relies on Lussi for such a teaching (See Col. 7, lines 10-62). While Lussi does teach the use of chips and flakes as decorative material, it does not teach the application of chips or flakes to be provided as claimed. Specifically, Lussi requires chips or flakes to be included as a component in an adhesive matrix (Col 3, lines 28-29) which is applied as a matrix layer (i.e, the particles are mixed in the adhesive and then applied as a layer, not placed into an applied layer as claimed) (Col. 4, lines 1-8). This structure is explicitly excluded from the claimed material as these particles would be completely coated with the substrate they are embedded (i.e., the adhesive). See the

specification as originally filed at Page 2, lines 20-22 excluding such a construction. There is no teaching or suggestion in the prior art to remove the particulate from the matrix layer as relied upon by the Office Action. In fact, there is no teaching or suggestion in either reference, much less the combination how chips or flakes could be applied as claimed independently of in a portion of a layer. The construction of Lussi provides a continuous applied matrix layer including the particulate as a portion thereof (applied only as a layer) and therefore Lussi, especially when combined with Weiner '004 teaches away from the claimed construction.

The Office Action correctly observes that the combination of Weiner '004 and Lussi does not teach the claimed order of the process steps. However, in attempting to reverse the order to rely on the cited references as the stated basis of the rejection, a number of problems are believed to be insurmountable to provide a proper basis for rejection. In fact, other than the applicant's specification, the applicant has found no basis for dispensing particulate on a conveyor and then applying the substrate layer as claimed in the citations provided for this rejection.

Reversing the order in Weiner '004 (i.e., putting the mesh down first and then applying the substrate) would not create a structure which meets the claimed limitations of that patent as the top surface of the vinyl would appear to form a single elevation and not at least two elevations as claimed and described in that patent (from wicking up the sides of the mesh or forming bubbles above the mesh). If texture were provided in the conveyor or lack of a perfectly planar mesh, then substrate would flow past runners (i.e., the proposition would also render such a construction unsuitable for its intended purpose, See MPEP 2143.02)

Furthermore, as stated above, while Lussi has “embedded” particulate, the embedding is done by mixing the particulate in an adhesive solution to form a “matrix” and then applying the matrix as a layer. Lussi does not teach imbedding particulates into a top surface of a formed layer as is believed to be relied upon as a basis of the rejection and is in the step of the rejected claim.

It should also be observed that in Weiner ‘004, the upper surface of the vinyl sheet product has at least two elevations, whether bubbles which rise above the mesh, or indentions which wick up on the sides of the mesh to form a valley below the mesh. In the claimed structure of claim 1, the upper surface will have an elevation corresponding to the conveyor surface. This should be found to be an “unexpected” result utilizing the rationale of the Final Office action, even if the inverse of steps is deemed proper procedure for formulating an obviousness rejection. Under MPEP 2144.09, this “unexpected” result or difference should render claim 1, non-obvious over the cited art as there is no way for the Weiner ‘004 reference to provide such an upper exposed surface. Furthermore, as an additional rebuttal of the obviousness rejection, when Weiner is combined with Lussi, if such is actually a proper *prima facie* obviousness rejection, is believed to teach away from placing design material on the conveyor and then the substrate as such a technique **cannot** form the claimed structure of the patent as explained above since the particulate in Lussi is only taught to be applied as a layer which would completely cover the conveyor.

In rejecting the Applicant’s arguments from the last Amendment & Response filed, the Examiner cited the *In re Keller* case (642 F.2d 413, 208 USPQ 871 (CCPA)). MPEP 2145 continues to state: “The claimed combination cannot change the principle of

operation of the primary reference or render the reference inoperable for its intended purpose.” As explained above, this is exactly what the Office Action does with the cited references as Weiner ‘004 cannot be made to meet its intended outcome by reversing the order as proposed by the Final Office Action.

Finally, the response cites *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971) for the proposition that if knowledge from one of ordinary skill is used and not solely from the applicant’s disclosure, then reconstruction of the claim would be proper. The applicant respectfully disagrees with the combination of references, even if the findings made in the Final Office Action are accurate. Specifically, there is no teaching as to how particulate would be embedded into a surface of a layer, or any motivation to do so, especially in light of the particulate in Lussi only being applied as a portion of a matrix.

Claims 2 and 13 stand or fall with claim 1. Allowance of claims 1, 2 and 13 is respectfully requested on these grounds.

## **2. Rejection of Claim 11-12**

Claim 11 depends from claim 1 and is believed to be allowable on the grounds provided above. Additionally, claim 11 requires the additional step of applying a second decorative material to an upper surface of the substrate. The Office Action cites Weiner ‘004 and Lussi, stating the combination teaches “a first decorative material in the form of PVC particles and a second decorative layer in the form of a metallic mesh.” Both Lussi and Weiner ‘004 each provide a single exposed side with some type of decorative indicia and an underlying substrate. This claim effectively requires indicia on both sides as claimed (i.e., top and bottom). Since neither Lussi nor Weiner ‘004 teach applying a



decorative material to two surfaces (one of which would be a bottom surface when installed), the combination of the two references would also omit at least this claimed element.

Claim 12 stands or falls with claim 11. Allowance of claims 11 and 12 is respectfully requested.

### **3. Rejection of Claims 15, 17 and 19**

The Applicant believes that the Examiner has a much better rationale for the rejection of claim 15 than claim 1. However, the embedding of mesh in the Weiner '004 patent is done to create a pattern of indentions or bubbles relative to the mesh as is explained in that reference. There is no such capability, purpose or result with embedding particulate or liquid as claimed in this claim. In fact, there are no runners for bubbles or wicking action to take place relative thereto as is described in the Weiner '004 reference.

Lussi requires that particulate be completely coated within a matrix to be applied as a layer, not the application of particulate into a layer. The applicant is still having a difficult time making the jump in logic that applying mesh to form bubbles or wicking action relative to a mesh when combined with fully coated particulate, teaches or suggests to one of ordinary skill in the art that the particulate could be separated from a matrix layer and applied into a top surface of a substrate based on the references cited. Since the claimed design material is particulate or liquid, it cannot be made to create the two elevation differential with the substrate required by the teachings of the Weiner '004 reference as explained above as it relates to claim 1 and would requires different structure to accomplish such a step. Accordingly the proposed combination renders Weiner '004

incapable of performing its intended function, the proposed combination is not believed to be a proper *prima facie* use of obviousness.

There is another fatal flaw in the rejection in that there is not believed to be a teaching or suggestion for removing the particulate in Lussi from the matrix to then have design material to introduce into a top surface of a substrate as claimed apart from the Applicant's disclosure. Lussi teaches the application of a complete matrix layer, and not the claimed structure of not completely covering the underlying material as claimed.

It is respectfully submitted that the combination of Lussi and Weiner '004 probably would render obvious the application of a matrix layer (including particulate) over a mesh with bubbles or wicking action on the sides of runners (and such a structure is not claimed by the applicant in this claim), but the removal of particulate from the matrix layer as has been performed by the Office Action to replace the matrix is not believed to be a proper *prima facie* obviousness rejection when applied into a vinyl substrate from above. The necessary structure to dispense liquid is missing from the Weiner '004 reference and would "requir[ing] a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principal under which the [primary reference] construction was designed to operate". *In re Ratti*, 270 F.2d 810, 813, 123 USPQ 349, 352 (CCPA 1959) from MPEP 2143.02.

Claims 17 and 20 stand or fall with claim 15. Allowance of claims 15, 17 and 20 is respectfully requested.

#### **4. Rejection of Claim 16**

Claim 16 depends from claim 15 and is believed to be allowable as argued for claim 15. This claim requires first design material to extend from the upper surface of

the product and then second design material to be located on the conveyor (on an opposite surface as the claims are properly interpreted). The Office Action cites the combination of Weiner '004 and Lussi for teaching such a structure.

As explained above as it relates to the rejection of claim 11, such a structure is not taught or suggested as neither Weiner '004 nor Lussi, nor the combination thereof. There is no teaching or suggestion of a two-sided product having first design material on one side, and second design material on the other as reflected by the scope of this claim.

Allowance of claim 11 is respectfully requested.

#### **B. Obviousness Rejection of Claims 3 and 18**

Weiner '033 shows the embedding of a scrim intermediate first and second vinyl layers as observed by the Examiner. Unfortunately, this observation destroys at least one of the obviousness rationales provided at least for claim 16. Specifically, for the rejection of claim 16, the scrim was relied upon as the second design material, but as required by claim 18, the scrim would be covered by the second vinyl layer and thus not visible and therefore, not design material as claimed.

Effectively this rejection is illustrative of the Office Action selectively taking individual portions of the prior art and selectively applying them, not in a consistent manner, but in a manner to follow the specification like a roadmap, which is believed to be an improper use of hindsight.

Claims 3 and 18 can stand or fall with the claims from which they depend, but the above inconsistency is believed to be significant as it relates to the use of impermissible hindsight instead of applying the teachings of the individual references and applying

them as one would of ordinary skill in the art as has been argued by the Office Action as the basis for rejection of the claims.

### **C. Obviousness Rejection of Claims 4-5 and 20**

Claims 4-5 depend from claim 1 and are believed to be allowable for the rationale provided for claim 1. Claim 20 depends from claim 15 and is believed to be allowable for the rationale provided for that claim. Additional arguments for allowance of these claims are also provided.

#### **1. Rejection of Claims 4 and 5**

Claim 4 includes the additional limitation that the design material be deposited as a liquid design material on a conveyor.

Erb does essentially teach the application of a liquid design material over a conveyor. However, Erb does not teach the introduction of a substrate over the liquid design material. In fact, Erb goes on to apply a press to smooth out the “liquid” into a continuous layer having a desired aesthetic effect.

If a substrate were added over the Erb liquid “splotches 24” before pressing into a layer, such a step would prevent the desired aesthetic effect from being created since application of the press would not result in the creation of the “continuous coating” (Col. 3, lines 15-18) formed of the material in the splotches, but instead would be invaded by the substrate material. Accordingly, when read in the context that it is provided, the combination of Erb with Weiner ‘004 teaches away from claim 4 and makes Erb unworkable for its intended purpose. How Lussi fits into a basis of rejection for claim 4, the Applicant remains confused. Nevertheless, both Lussi and Erb provide for continuous layers and not for particulate or liquid spaced material by substrate deposited

relative to an exposed surface of a vinyl product as the claimed method provides, and their combination with Weiner '004 does not provide such structure either. It is important to remember that all of the particulate in Lussi is coated within the matrix.

This rejection is believed to fail to provide a prima facie case of obviousness and should be withdrawn as there is no teaching or suggestion to provide the method as claimed by claim 4.

Much of the rationale provided above for claim 1 is also particularly applicable as it relates to the combination of references with Weiner '004 teaching away from claim 4. There is no teaching to suggest that placing the mesh of Weiner '004 on a conveyor which could produce the wicking action of the substrate or the creation of the bubbles as is described by that reference. When a liquid design material is relied upon by the Office Action to replace the mesh, there are no “runners” for which at least two elevations may be based. Accordingly, the combination of Weiner '004 with Erb (and Lussi) teach away from the claimed structure and Claim 4 is believed to be separately allowable on this basis. Allowance is respectfully requested.

Claim 5 requires the at least partial curing of the liquid design material. While Erb provides for partial curing of liquid design material, it still fails to teach the addition of a substrate over at least partially cured design material and as explained above, the proposed combination of references actually teaches away from such a method.

Claims 4 and 5 are believed to also be for the arguments provided in this section. Allowance of claims 4 and 5 is respectfully requested.

## **2. Rejection of Claim 20**

Claim 20 has also been rejected based on the combination of Weiner '004 with Lussi and Erb. Col. 2, lines 35-47 has been cited for the proposition that Erb teaches a laterally moving applicator. While this passage describes “side to side” movement of the blade 13 relative to tray 11, with proper reference back to Figures 1 and 2, one will see that this “side to side” movement is in the direction of travel of feeding the vinyl product, and not “laterally” as is claimed by the applicant.

There being no citation provided for the claimed “lateral” movement as properly interpreted in relationship to the specification as originally filed, claim 20 is believed to be properly allowable on this separate ground.

Allowance of claim 20 is respectfully requested.

## **D. Obviousness Rejection of Claims 6-10**

### **1 Rejection of Claim 6**

Claim 6 depends from claim 4 and is believed to be allowable for the rationale provided above for claim 4. Claim 6 provides the additional claim limitation of applying at least two distinct colors of liquid design material. A cobbling of Weiner '004, Lussi, Erb are utilized to reject this claim with Hensler which does describe the use of two colors of liquid or solid vinyl being applied onto a belt. In fact the two colors are used to form a border about a center portion with the vinyl being applied directly to a conveyor 26 and then cured in oven 38 and embossed with rollers 42.

However, in the Hensler reference, the applied decorative material completely covers the conveyor which is at odds with the claimed structure. Instead of admitting this inconsistency, the Office Action, lifts the two colors of applied vinyl and appears to apply

such a teaching to particulate of Lussi. The fact that the particulate in Lussi is contained within a complete layer matrix is ignored. These teachings are also combined with Erb to teach that such color spots are applied to a conveyor (even though they are subsequently spread into a uniform layer...which is ignored), and the Weiner reference utilized for the proposition that imbedding of mesh to form bubbles or wicking up on the sides of mesh effectively teaches any and all types of imbedding design material into a substrate. The Applicant simply disagrees with this interpretation of the obviousness rejection and believes the MPEP and court's decision support the applicant's interpretation.

First, the proposed modification cannot change the principle of operation of a reference. MPEP 2143.02. As the Patent Office would have to admit, such a rejection requires "a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principal under which the [primary reference] construction was designed to operate" is an improper obviousness rejection. See *In re Ratti*, 270 F.2d 810, 813, 123 USPQ 349, 352 (CCPA 1959).

There is not believed to be a way to modify the screen imbedding system of Weiner '004 with a liquid or particulate system as claimed. The other references provide no teaching how this would occur either. If the roller which applied the mesh were simply replaced with a hopper, the vinyl substrate has already been put down and the design material can not reach the conveyor as claimed. There is certainly no teaching in Weiner '004 to first apply the mesh and then apply the substrate, and, as explained above, such a construction can not be forced to meet the limitations of the claims in that reference because wicking up the runners or forming bubbles above the runners cannot

occur in such a construction and Weiner '004 would be rendered unworkable for its intended purpose.

Allowance of claim 6 on this separate ground is respectfully requested.

## **2. Rejection of Claims 7-9**

Claim 7 depends from claim 4 and is believed to be allowable for the rationale provided above for claim 4. Claim 7 provides the additional claim limitation of a hopper with a plurality of orifices configured to apply the liquid design material from the hopper through the orifices to the conveyor.

The hopper 24 of Hensler utilized to dispense the liquid vinyl does not appear described in sufficient detail in that reference to know if it has a slit from which the vinyl is deposited on the conveyor or orifices. Regardless of this non-discussed element, the Applicant does not understand how this reference would be applied in conjunction with Weiner '004 and the other references to create a structure which could apply liquid to a conveyor with a hopper and then a substrate which is then cured to provide a vinyl sheet product without at a minimum "requir[ing] a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principal under which the [primary reference] construction was designed to operate". *In re Ratti*, 270 F.2d 810, 813, 123 USPQ 349, 352 (CCPA 1959) from MPEP 2143.02. Quite simply, there are no runners for which bubbles can form (or wicking action to take place relative to) in the primary reference. The proposed rejection negates the construction and basis of operation of the Weiner '004 reference.

Claim 7 stands or falls on this separate basis. Allowance of claim 7 is respectfully requested.



### **3. Rejection of Claims 8 and 9**

Claim 8 depends from claim 7 and is believed to be allowable on the grounds articulated. Claim 8 further requires a hopper to be moved while depositing the liquid design material. Instead of citing a reference, the Office Action states that “a vibrating hopper is well known in the art”.

While moving could certainly include vibrating, the Applicant respectfully disagrees with this rejection. The moving hopper has been shown in some embodiments to give rise to the effect shown in Figure 3 of the specification as originally submitted. None of the cited reference provide such effect in such a manner and the combination of all of them is not believed to teach such an effect. In fact, moving the screen (in a direction other than into the substrate) while embedding it would likely impair the desired effect in the Weiner '004 reference which would therefore once again result in a modification which would inappropriately change the principal of operation of that reference and/or make it unsatisfactory for its intended purpose. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In Erb, the blade 13 moves, not the tray 11. The Erb structure cannot be made to provide the design elements created by the applicants method shown in the embodiment of Figure 3 even if a substrate could be added into as a step as effectively as has been proposed by the Office Action (which is believed to be improper).

Claim 8 is believed to be separately allowable on this ground. Claim 9 depends from claim 8 and for the purpose of this appeal, claim 9 can stand or fall with claim 8. Allowance of claims 8 and 9 is respectfully requested.

### **3. Rejection of Claim 10**

Claim 10 depends from claim 4 and is believed to be allowable for the rationale provided above for claim 4. Claim 10 provides the additional claim limitation of a embossing the liquid design material with a roller prior to applying the first vinyl substrate layer. Hensler teaches using a roller to emboss...after curing the vinyl product in the oven (and not before). Furthermore, Hensler does not teach applying a substrate over design material, so there is no basis to combine Hensler with a step performed before curing the vinyl product. As explained in the specification, the embossed portion on the roller would tend to force the design material into that pattern before adding the substrate. This is a very different effect than embossing a cured product where design material and substrate would be treated with the roller.

This rejection is believed to be further evidence of picking and choosing of unrelated elements from various vinyl sheet product references and cobbling them together using the applicant's specification and then arguing that such elements were what was known to one of ordinary skill in the art. The Applicant respectfully disputes such rejection and believes the Board will support the applicant in the application of the obviousness standard as applied to this case.

Allowance of claim 10 is believed to be separately allowable on this ground and allowance is respectfully requested.

### **E. Obviousness Rejection of Claim 14**

Claim 14 depends from claim 1 and is believed to be allowable for the rationale provided above. However, this obviousness rejection is believed to be another proposed combination making the suggested teachings unworkable for their intended purpose as it

relates to its component parts, therefore resulting in a teaching away of the claimed invention. Claim 14 requires the conveyor to have at least two heights and provide a texture to a lower surface of the vinyl sheet product.

If the mesh in Weiner '004 were put on the two height conveyor and then covered with substrate the claimed bubble structure could not be provided as is described and claimed throughout that reference. The substrate would conform to the conveyor surface and not wick or make bubbles as taught by the Weiner '004 reference. Accordingly, combining Weiner '004 with the remaining references, particularly Suzuki, therewith, is not believed to be proper. See MPEP 2143 citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure). Under MPEP 2143.01 the proposed modification renders the prior art unsatisfactory for its intended purpose citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Also, as explained above as it relates to claim 1, the proposed modification changes the principal of operation of the Weiner '004 reference in an improper way thereby failing the prima facie standard for an obviousness rejection.

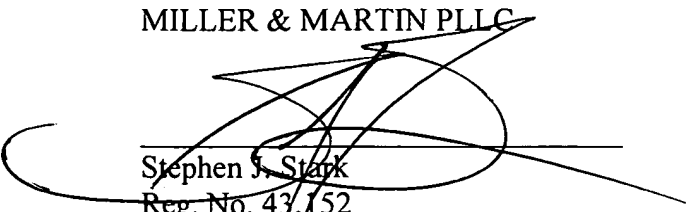
Claim 14 is separately allowable on these grounds, and allowance of claim 14 is respectfully requested.

### III. CONCLUSION

Claims 1-20 are not believed to be obvious over Weiner '004, Lussi and others for the rationale provided in this brief. Allowance of claims 1-20 is respectfully requested.

Respectfully submitted,

MILLER & MARTIN PLLC



Stephen J. Stark

Reg. No. 43,152

Attorney for Applicant

832 Georgia Ave., Suite 1000

Chattanooga, TN 37402-2289


(423) 785-8229

## CERTIFICATE OF MAILING

I hereby certify that the preceding Supplemental Brief on Appeal is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, Virginia 22313-1450

On this 2nd day of April, 2007.

  
Beverly L. Middleton

## APPENDIX A

1. A method of creating a vinyl sheet product comprising the steps of:  
  
depositing a design material onto a conveyor, said design material in the form of one of drips, streams, chips and pellets deposited so as to not completely cover a top surface of the conveyor where applied;  
  
applying a first vinyl substrate layer of a predetermined height over on the conveyor over the design to create a vinyl sheet product, at least a portion of the design material remaining in contact with the conveyor; and  
  
curing the vinyl sheet product, wherein when the vinyl sheet product is removed from the conveyor, the design material forms an indicia relative to the first vinyl substrate layer.
2. The method of claim 1 further comprising the step of applying a scrim to an exposed surface of the first vinyl substrate layer after applying the first vinyl substrate layer.
3. The method of claim 2 further comprising the step of applying a second vinyl substrate layer over the scrim.
4. The method of claim 1 wherein the step of depositing the design material further comprises depositing a liquid design material onto the conveyor.

5. The method of claim 4 further comprising the step of at least partially curing the liquid design material prior to applying the first vinyl substrate layer.
6. The method of claim 4 further comprising the step of applying at least two distinct colors of liquid design material.
7. The method of claim 4 wherein the step of depositing the liquid design material further comprises providing a hopper having a plurality of orifices configured to apply the liquid design material from the hopper through the orifices to the conveyor.
8. The method of claim 7 wherein the hopper is moved while depositing the liquid design material to the conveyor.
9. The method of claim 7 wherein the hopper is moved in an laterally reciprocating motion while depositing the material to the conveyor.
10. The method of claim 4 further comprising the step of applying a roller having an embossed indicia thereon to the liquid design material prior to applying the first vinyl substrate layer.
11. The method of claim 1 further comprising the step of applying a second design material to the exposed upper surface of the first vinyl substrate layer prior to curing the vinyl sheet product, wherein at least a portion of said second design material extends at least planar with the upper surface of the first vinyl substrate layer.

12. The method of claim 11 wherein after applying the second design material, at least a portion of the second design material extends a distance above the upper surface of the first vinyl substrate layer.

13. The method of claim 1 wherein the step of curing the vinyl product further comprises transporting the product through an oven, and further comprising the step of cooling the cured vinyl after the product has left the oven.

14. The method of claim 1 further comprising the step of providing a conveyor having at least two different heights thereby imparting a texture to a lower surface of the vinyl sheet product.

15. A method of creating a vinyl sheet product comprising the steps of:  
applying a first vinyl substrate layer over a conveyor;  
applying a design material in the form of one of drips, streams, chips and pellets onto an upper exposed surface of the first vinyl substrate layer to create a vinyl sheet product, wherein at least a portion of the design material extends into and at least to the upper surface of the first vinyl substrate layer and does not completely cover the first vinyl substrate layer where applied;  
curing the vinyl sheet product, wherein when the vinyl sheet product is removed from the conveyor, the design material forms an indicia relative to the first vinyl substrate layer.



16. The method of claim 15 wherein the first vinyl substrate layer is applied over a second design material previously applied to the conveyor, wherein at least a portion of the second design material remains in contact with the conveyor until after the vinyl sheet product is cured.
17. The method of claim 15 further comprising the step of applying the first vinyl substrate layer over a scrim transported by the conveyor.
18. The method of claim 17 wherein the scrim is supported by a second vinyl substrate layer previously applied to the conveyor.
19. The method of claim 15 wherein the design material is one of a solid polyvinyl chloride, polyethylene, polypropylene, and a metal.
20. The method of claim 15 wherein the design material is applied with a laterally moving applicator.

## **APPENDIX B: EVIDENCE APPENDIX**

None

## **APPENDIX C: BOARD DECISION APPENDIX**

None